REMARKS

I. Introduction

Claims 1-27 are pending in the above application.

Claims 1, 7-9, 11, 14-17, 19-21 and 23-27 stand rejected under 35 U.S.C. § 102.

Claims 2-6, 12, 18 and 22 stand rejected under 35 U.S.C. § 103.

Claims 1, 9, 20, 21, 24, 25 and 27 are independent claims.

II. Prior Art Rejections

A. Claims 1, 7-9, 11, 14-17, 19-21 and 23-27 stand rejected under 35 U.S.C. § 102 as being anticipated by Lin et al. (U.S. Pat. 6,603,849).

Anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed in a prior art reference as arranged in the claim. See, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986); *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 198 (Fed. Cir. 1983).

Lin does not disclose or suggest a method of seamlessly transferring a communication session between a first device and a correspondent device on an IP network to another device via a session specific IP address. Lin merely discloses to forward a telephone call from one network element to another network element to allow a mobile unit to complete a call when it roams out of its network or to connect to a pre-designated secondary device before establishing the call. See, col. 3: 25 through col. 4: 44; and col. 5: 13-25. More particularly, Lin discloses to use alternative numbers associated with the network elements to initially complete a call to a mobile station (MS) 20 or alternative endpoint when it is being serviced by different networks, i.e. the alternative numbers referred to in Lin are concerned with the various network elements required

to complete a call to MS 20 or another endpoint, they are not concerned with transferring a session from MS 20 to another user device. See, col. 4: 45 through col. 6: 12. Moreover, Lin does not disclose to generate and use a session specific IP address to transfer a session from itself to another device.

Accordingly, as Lin does not disclose each and every element of any of independent claims 1, 9, 20, 21, 24, 25 or 27, Lin does not anticipate any of these claims. Likewise, since claims 6-8 depend on claim 1 and incorporate all of the limitations thereof; claims 11, 14-17 and 19 depend on claim 9 and incorporates all of the limitations thereof; and claim 23 depends on claim 21 and incorporates all of the limitations thereof; Lin does not anticipate these claims as well. Hence, Applicant respectfully requests the rejection to be withdrawn.

B. Claims 5 and 10 stand rejected under 35 U.S.C. § 102 as being unpatentable over Lin alone.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *Ecolochem Inc. v. Southern California Edison Co.*, 227 F.3rd 1361, 56 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992); and *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). See also MPEP 2143.01.

Regarding claim 5, Lin does not disclose or suggest to transfer a communication session between a first device and correspondent device to a second device which includes the step of

generating a wake-up message once the communication session is no longer to be transferred and cause the first device to resume receiving communication sessions addressed to its IP address. The Office action appears to acknowledge the deficiency in Lin, but concludes that it would have been obvious. However, Lin does not even disclose to transfer a communication session from one device to another at all, as discussed above. Indeed, in the portions of Lin relied upon by the examiner. Moreover, Lin is concerned with a call completion with a single device (e.g. MS 20) in different network, i.e. call set up (see, Fig. 4, the last step is "connect call"), there is no discussion of transferring an active communication session to another device and then back to the first device.

Regarding claim 10, the rejection in the Office action appears to attempt to bootstrap on the rejection of claim 5 to reject claim 10. The methodology in the rejection is flawed. The rejection of claim 5 is improper as discussed above and should be withdrawn. Moreover, regardless of the status of claim 5, the attempt to establish some form of relationship between a wake-up messages (in claim 5) and using the first device permanent IP address for communications to another device (claim 10) is simply a creative effort to reject claim 10. There is simply no basis in the prior art, and none has been shown in the Office action, to support the logical reasoning underlying the rejection of claim 10. The Examiner is respectfully reminded that a rejection must be based on a reasonable degree of scientific certainty, not mere speculation. See, MPEP 2144.02.

Accordingly, as Lin neither discloses nor suggests all of the limitations of either of claims 5 or 10, Lin does not render claims 5 or 10 unpatentable.

C. Claims 2-4, 6, 12, 18 and 22 stand rejected under 35 U.S.C. § 102 as being unpatentable over Lin in view of Johnston (U.S. Pat. 6,373,946).

Neither Lin nor Johnston, taken alone or in combination disclose or suggest all of the limitations of claims 2-4, 6, 12, 18, or 22, which depend on and incorporate the limitations of claims 1, 9 or 21, respectively. Lin does not disclose the limitations of either claims 1, 9 or 21 as discussed above. Johnston also does not disclose such, and the Office action does not rely on Johnston as disclosing such.

Accordingly, as neither Lin nor Johnston, taken alone or in combination do not disclose or suggest all of the claimed limitations of claims 2-4, 6, 12, 18 or 22, the combination of Lin and Johnston does not render these claims unpatentable.

III. Conclusion

Having fully responded to the Office action, the application is believed to be in condition for allowance. Should any issues arise that prevent early allowance of the above application, the examiner is invited contact the undersigned to resolve such issues.

To the extent an extension of time is needed for consideration of this response, Applicant hereby request such extension and, the Commissioner is hereby authorized to charge deposit account number 502117 for any fees associated therewith.

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Respectfully submitted,

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